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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,068	06/05/2006	Sophie Creux	26217	9849
22889	7590	12/15/2008		
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			EXAMINER COLE, ELIZABETH M	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			12/15/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,068

Applicant(s)

CREUX ET AL.

Examiner

Elizabeth M. Cole

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1-6, 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation that the composition is "substantially free of lithium". The specification at page 3 states that the composition contains no lithium oxide but that is not the same as "substantially free".
2. Claims 1-6,8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. It is not clear what is meant by "substantially free of lithium". Does this mean that the composition contains no lithium oxide or does it mean that it may comprise some lithium but not a substantial amount? Further, it is not clear what would be considered a substantial amount. For purposes of the art rejection below, it will be presumed that "substantially free" means that some lithium may be present but that it should be less than 1 percent.
4. Also, in claims 4, 5, 11,12, 19-20, the word preferably is included after a recitation of a ratio or range. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation

given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10

USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Neely, U.S. Patent No. 4,199,364. Neely discloses a glass composition comprising SiO₂ in amounts of 55-61 wt percent; Al₂O₃ in amounts of 12-18 weight percent; CaO in amounts of 14-18 weight percent and MgO in amounts of 4-10 weight percent. See abstract. The composition can be used to make glass fibers. The amounts anticipate the claimed amounts. The amounts of B₂O₃, TiO₂, Na₂O + K₂O, F₂ and Fe₂O₃ are below the maximum values set forth in the claims. See col. 4, lines 25-53 and col. 5, lines 1-26. Neely teaches that lithium oxide may be present in an amount of 0.1 percent, which would seem to meet the limitation of being "substantially free" of lithium. Since Neely

teaches amounts which encompass the claimed ranges, Neely also teaches the ranges and ratios set forth in claims 4-6,9-13.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Neely, U.S. Patent No. 4,199,364. Neely discloses a glass composition comprising SiO_2 in amounts of 55-61 wt percent; Al_2O_3 in amounts of 12-18 weight percent; CaO in amounts of 14-18 weight percent and MgO in amounts of 4-10 weight percent. See abstract. The composition can be used to make glass fibers. The amounts anticipate the claimed amounts. The amounts of B_2O_3 , TiO_2 , $\text{Na}_2\text{O} + \text{K}_2\text{O}$, F_2 and Fe_2O_3 are below the maximum values set forth in the claims. See col. 4, lines 25-53 and col. 5, lines 1-26. Neely teaches that lithium oxide may be present in an amount of 0.1 percent, which would seem to meet the limitation of being "substantially free" of lithium. Since Neely teaches amounts which encompass the claimed ranges, Neely also teaches the ranges and ratios set forth in claims 4-6,9-13. Neely teaches T_{liquidus} temperatures within the claimed range. See table IX. Neely does not disclose the claimed Young's Modulus, or $T_{\text{log}}=4$. However, since Neely discloses a glass composition and yarn having the same components present in the same amounts, it is reasonable to expect that the material of Neely would possess the claimed properties. Where applicant claims a composition in terms of a function,

property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA1977).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 and 8-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 12-15 of copending Application No. 11/722,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims a composition having the overlapping ranges of the same constituents which is useful for making glass fibers

and yarns. Although the claims of US '039 include lithium oxide, it is present in amounts of 0.1-0.8 which indicates that the material is substantially free of lithium.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-6 and 8-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12-15 of copending and allowed Application No. 10/129,265 in view of Tamura, U.S. Patent Application Publication No. 2001/0011058. US '265 claims a composition for making glass fibers which has overlapping ranges of the same constituents except that US '265 claims 0-5% of MgO while the instant application claims 6-12%. However, Tamura teaches that in forming glass compositions for making glass fibers that it is known to employ MgO in amounts of 1-9 %. Tamura teaches that the MgO decreases the viscosity of the glass and improves the meltability of the glass. See paragraph 0014. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the amount of MgO from within the ranges taught by Tamura in order to arrive a composition having the desired properties including meltability and viscosity.

This is a provisional obviousness-type double patenting rejection. It is noted that US 10/129,265 has been allowed but has not yet issued.

11. Applicant's arguments filed 10/17/08 have been fully considered but they are not persuasive. Applicant argues that the Neely composition contains lithium. However, the claims do not recite that the material contains no lithium but that it is "substantially free".

A material which contains 0.1% of a component is "substantially free" of that component.

12. Applicant's arguments with regard to the double patenting rejections are that the claimed compositions are not the same. However, although the claims of US '039 include lithium oxide, it is present in amounts of 0.1-0.8 which indicates that the material is substantially free of lithium. Further, with regard to US '265, the difference is in the amount of MgO employed. Tamura teaches that the MgO decreases the viscosity of the glass and improves the meltability of the glass. See paragraph 0014. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the amount of MgO from within the ranges taught by Tamura in order to arrive a composition having the desired properties including meltability and viscosity. Therefore, the rejection has been maintained.

13. The amendment to the claims reciting the particular amount of CaO is sufficient to overcome the Tamura reference since Tamura teaches that 16% is the minimum amount for CaO.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c